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**REMARKS**

The present application relates to hybrid maize plant and seed 34N16. Claims 5-8, 12, 20-21, 25, 33 and 41-58 have been canceled. Claims 9-11, 13-19, 22-24, 26-32, and 34-40 were previously canceled in the Amendment After Final submitted on May 27, 2003. Claims 1 and 2 have been amended. Claims 59-72 have been added at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. No new matter has been added by the present amendment. Applicant respectfully requests consideration of the following remarks.

**Detailed Action*****A. Status of the Application***

Applicant acknowledges the finality of the previous Office Action has been withdrawn pursuant to 37 C.F.R. § 1.114.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 8, 12, 21 and 25 remain rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for the reasons of record stated in the Office Action mailed September 20, 2003.

Applicant traverses this rejection. However, although not acceding to the Examiner's rejection, in order to expedite prosecution claims 8, 12, 21 and 25 have now been canceled, alleviating this rejection.

Claim 58 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner states claim 58 is indefinite in its recitation of "no statistically significant variation from 34N16".

Applicant traverses this rejection. However, although not acceding to the Examiner's rejection, in order to expedite prosecution claim 58 has been canceled, thus alleviating this rejection.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 8, 12, 21, 25 and 43-58 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated on page 5 in the Office Action mailed February 25, 2003.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claims 8, 12, 21, 25 and 43-58, thus alleviating this rejection.. Applicant has added new claims 59-72 at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. Applicant respectfully submits the claims now come within the purview of the written description requirement and request reconsideration.

Claims 8, 12, 21, 25 and 43-58 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is more nearly connected, to make and/or use the invention, as stated on page 5 in the Office Action mailed February 25, 2003.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claims 8, 12, 21, 25 and 43-58, thus alleviating this rejection. Applicant has added new claims 59-72 at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. Applicant respectfully requests reconsideration.

In addition, Applicant herein submits the Summary of the Invention section has been amended to include the ATCC Accession Numbers of the inbred parents GE568102 and GE534776 on page 7 and the Deposits section has been amended in order to properly include both the hybrid maize plant 34N16 and the inbred parents GE568102 and GE534776 and the corresponding ATCC Accession Numbers within the Deposit paragraph on page 50. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification. The Specification has now been amended to correct these minor changes. The Applicant further provides assurance that at least 2500 seeds of hybrid maize plant 34N16 and the inbred parents GE568102 and GE534776 have been deposited with the ATCC. Copies of the ATCC deposit receipts are included in this response. In view of this assurance, the

rejection under 35 U.S.C. § 112, first paragraph, should be removed. (MPEP § 2411.02). Such action is respectfully requested.

In light of the above amendments and remarks, Applicant respectfully request reconsideration and withdrawal of the rejections to claims 8, 12, 21, 25 and 43-58 under 35 U.S.C. § 112, first paragraph.

#### Summary

Applicant acknowledges that claims 1-7, 20, 33 and 41-42 are allowed.

Applicant further acknowledges that claims 1-10, 12-14, 16-18, 20-23, 25-27 and 29-31 are deemed free of the prior art. The Examiner further states the prior art fails to teach or fairly suggest the particularly claimed maize plants with their unique complement of genotypic and morphological characteristics, or methods of using them. This clearly indicates that hybrid maize plant 34N16 as a whole is considered to be distinguishable from the prior art for the purposes of novelty and non-obviousness. Therefore, Applicant respectfully submits that the deposit of the representative seed of 34N16 and inbred parents GE568102 and GE534776 should satisfy the description requirement. In light of the above, Applicant respectfully submits that the rejections under 35 U.S.C. § 112, first paragraph as improper and requests reconsideration and withdrawal of these rejections.

Applicant further acknowledges that claims 59-72 have been agreed upon as allowable by Supervisory Patent Examiner Amy Nelson as aforementioned, thereby placing these claims in form for allowance. Applicant has canceled all non-allowable claims thereby placing the application in condition for allowance and has complied with all requirements of form set forth in previous office actions.

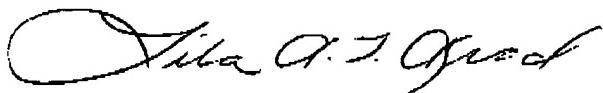
#### Conclusion

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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- pw/LA -

OCT 06 2003

# ATCC

1020 University Blvd • Bethesda, VA 20810-2209 • Telephone: 703-323-2700 • FAX: 703-323-2745

The American Type Culture Collection (ATCC) has received your deposit of seeds in connection with the filing of an application for patent. The following information is provided to fulfill Patent Office requirements.

**Name and Address of Depositor:**

Pioneer Hi-Bred International, Inc.  
Attn: Steve Callstein  
7100 NW 62<sup>nd</sup> Avenue  
P.O. Box 1000  
Johnston, IA 50131-1000

**DOCKETED**

OCT 08 2003

**Deposited on Behalf of:**

Pioneer Hi-Bred International, Inc.

**Date of Receipt of Seeds by the ATCC:**

September 9, 2003

Scientific DescriptionDepositor's ReferencePatent Deposit Designation

Hybrid corn (maize) seed

34N16

PTA-5461

**The ATCC understands that:**

1. The deposit of these seeds does not grant ATCC a license, either express or implied, to infringe the patent, and our release of these seeds to others does not grant them a license, either express or implied, to infringe the patent.
2. If these seeds should die or be destroyed during the effective term of the patent, it shall be your responsibility to replace them with living seeds of the same type. It is also your responsibility to supply a sufficient quantity for distribution for the deposit term.

Prior to the issuance of a U.S. Patent, the ATCC agrees in consideration for a one-time service charge, not to distribute these seeds or any information relating thereto or to their deposit except as instructed by the depositor or relevant patent office. After a relevant patent issues, and we are instructed to release the seeds, they will be made available for distribution to the public without any restrictions.

The ATCC agrees to maintain the seeds for a period of 30 years from deposit date, or 5 years after the most recent request for a sample, whichever is longer.

We will inform you of requests for the seeds for 30 years from date of deposit.

The seeds were tested September 16, 2003 and were viable.

American Type Culture Collection

By Marie Harris  
Marie Harris, Patent Specialist  
ATCC Patent Depository

Date: October 2, 2003